



03 JAN 2007

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In re Application of	:	
YOKOYAMA.	:	
Application No.: 10/595,093	:	DECISION ON
PCT No.: PCT/US04/26701	:	
Int. Filing Date: 17 August 2004	:	PETITION
Priority Date: 22 August 2003	:	
Attorney's Docket No.: 58821US006	:	UNDER 37 CFR 1.47(b)
For: PRECURSOR PASTE AND METHOD OF:	:	
PRODUCING THE SAME	:	

This is a decision on petition under 37 CFR 1.47(b), filed 25 September 2006 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing inventor Chikafumi Yokoyama. Petitioner requested a two month extension of time, the fee for which was charged to applicant's deposit account per his authorization.

### **BACKGROUND**

On 17 August 2004, applicant filed international application No. PCT/US04/26701 which claimed a priority date of 22 August 2003, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 03 March 2005.

On 09 February 2006, within 30 months from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee.

On 26 May 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b) must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 25 September 2006, petitioner filed the instant petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was accompanied by a declaration of Carolyn A. Fischer and a copy of a secrecy agreement signed by the inventor.

### **DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a

showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has satisfied Item (1) with payment of the requisite petition fee and Item (3) with a statement of the last known address of the inventor.

With regard to Item (2), Toshio Tamura states that he contacted the nonsigning inventor to obtain his signature on the assignment and declaration documents and the inventor refused to sign. The declaration of Ms. Fischer states that she sent, via email (29 August 2006), a copy of the application papers to the nonsigning inventor. A review of her email indicates that she sent copies of four different applications to Mr. Yokoyama.

Mr. Yokoyama's reply email (30 August 2006) references a different attorney docket number FN9452US005 (which is not a U.S. application) than the attorney docket number associated with the above referenced application. Furthermore, Mr. Yokoyama indicates that he is refusing to sign application papers which named additional inventors he contends are not coinventors. The application at issue here is the U.S. national stage of PCT/US04/26701 in which Mr. Yokoyama is the sole inventor. Thus, it seems that Mr. Yokoyama is confused regarding which application is being asked to sign and does not clearly demonstrate that Mr. Yokoyama is refusing to sign this application.

Petitioner must provide proof that the inventor was presented with a copy of the application papers (including specification, claims, and any drawings) in order to conclude that the inventor refuses or is unavailable to sign the application. See MPEP. 409.03(d), which states in pertinent part, "a refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers." Here, the nonsigning inventor was presented with copies of the several application papers and thus, it is unclear whether he is refusing to sign the application at issue. Petitioner must present sufficient evidence to conclude that the inventor refuses to sign the application. The statement of someone having first hand knowledge of the facts is required. See MPEP. 409.03(d) for further instructions. Item (2) is not satisfied.

As for Item (4), petitioner has not provided a declaration, in compliance with 37 CFR 1.497(a) and (b) and executed on behalf of the inventor by the 37 CFR 1.47(b) petitioner and is required. Item (4) is not satisfied.

Regarding Item (5), Section 409.03(f) of the MPEP, **Proof of Proprietary Interest**, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324)....

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

No assignment signed by the inventor was attached to the petition to prove this interest.

Where there is no written agreement to assign or the invention has not been assigned, petitioner must demonstrate a proprietary interest by an appropriate legal memorandum. No such memorandum accompanied the petition.

Here Petitioner, in attempting to prove that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the subject matter to justify filing the application, provided an agreement entitled "Secrecy Agreement" where the employee (nonsigning inventor) agreed to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. A firsthand knowledge statement that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant and that all conditions were met is required. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant. Item (5) is not satisfied.

As for Item (6), irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party and to prevent irreparable damage." No such statement has been presented. Thus, item (6) is not yet satisfied.

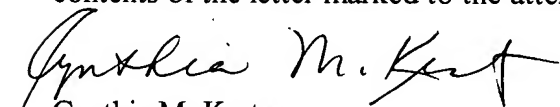
Accordingly, items (2), (4), (5) and (6) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

**CONCLUSION**

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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